

REMARKS

Status

Claims 1-13 and 15-22 will be pending upon entry of the present amendment, with claims 11-13 being withdrawn. Support for the amendments and new claims can be found in the original claims and throughout the specification. No new matter will be added upon entry of the amendments.

Discussion

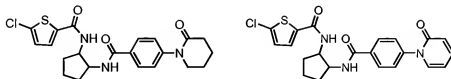
Applicants have now amended claims 1-9 to correspond to the restriction requirement.

Applicants respectfully request reentry of claims 11-13 upon finding of allowable subject matter in claims 1-10.

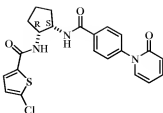
The rejection of claim 9 under 35 U.S.C. §112, 2nd paragraph, has been obviated by appropriate amendment. The reference to Table 1 in original claim 9 has been replaced by the examples from Table 1 that correspond to the current restriction requirement. Withdrawal of this rejection is respectfully requested.

The rejection of Claims 1-10 under 35 U.S.C. §102(a) or (c) over Pinto (US 6,967,208) is respectfully traversed.

Two of the eight compounds from Pinto cited on page 6 of the Office Action are shown below.



As with the above two compounds, all of the cited compounds of Pinto are based on a 1,2-diaminocyclopropyl core. This core is not recited in the present claims. Rather, the presently claimed invention recites one specific diastereomer of each of the claimed cores (e.g., down, cis 1,2-disubstituted cyclopentane). For example, Example 1 of the present invention, shown below, is a 1R,2S cyclopentane.



Contrary to the Office Action, Pinto does not show such a compound.

Embodiment [15]/Claim 15 of Pinto recite non-stereospecific compounds or pharmaceutically acceptable salts thereof, without mention of stereoisomers thereof. More importantly, no mention is made in Embodiment [15]/Claim 15 of the down,cis-1,2-disubstituted cyclopentyl compounds that are presently claimed. Thus, while it might be obvious to make the above-shown Example 1 of the present invention or others in view of Embodiment [15]/Claim 15, this does not mean Example 1 is anticipated. Withdrawal of the §102 rejection over Pinto is, therefore, respectfully requested.

The rejection of Claims 1-10 under 35 U.S.C. §103(a) over Pinto (US 6,967,208) or Pinto-I (US 6,989,391) is respectfully traversed.

Applicants submit that Pinto and Pinto-I are disqualified under 35 USC §103(c) as prior art against the presently claimed invention as the subject matter of Pinto and Pinto-I and the presently claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The undersigned hereby states that since the present application, 10/801,469, and Pinto and Pinto-I were, at the time the invention of application 10/801,469 was made, commonly owned by Bristol-Myers Squibb, Pinto and Pinto-I are disqualified from being used in a rejection under 35 U.S.C. 103(a) against application 10/801,469. The evidence supporting common ownership of application 10/801,469 and Pinto and Pinto-I is the Assignment to Bristol-Myers Squibb Company at Reel 04713/Frame 0268, Reel 015548/0459, and Reel 015709/0069 in application 10/801,469 and the Assignment to Bristol-Myers Squibb Pharma Company at Reel 014607/Frame 0160 in Pinto and the Assignment to Bristol-Myers Squibb Pharma Company as shown on the first page of Pinto-I, which is a Divisional of Pinto.

The rejection of Claims 1-10 under 35 U.S.C. §103(a) over Jacobson (US 6,951,872) is respectfully traversed.

Applicants submit that Jacobson is disqualified under 35 USC §103(c) as prior art against the presently claimed invention as the subject of Jacobson and the presently claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” The undersigned hereby states that since the present application, 10/801,469, and Jacobson were, at the time the invention of application 10/801,469 was made, commonly owned by Bristol-Myers Squibb, Jacobson is disqualified from being used in a rejection under 35 U.S.C. 103(a) against application 10/801,469. The evidence supporting common ownership of application 10/801,469 and Jacobson is the Assignment to Bristol-Myers Squibb Company at Reel 04713/Frame 0268, Reel 015548/0459, and Reel 015709/0069 in application 10/801,469 and the Assignment to Bristol-Myers Squibb Pharma Company at Reel 016195/Frame 0602 in US 6,710,058 of which Jacobson is a divisional (and the front page Jacobson shows that it is assigned to Bristol-Myers Squibb Pharma Company).

The provisional rejection of Claims 1-10 under the judicially created doctrine of obviousness-type double patenting over Claims 1 and 16 of Pinto II (USAN 11/198,801) is respectfully requested to be held in abeyance until allowable subject matter is found in the above-identified application.

The provisional rejection of Claims 1-10 under the judicially created doctrine of obviousness-type double patenting over Claims 1 and 9 of Shi (USAN 10/952,204) is respectfully traversed. Applicants note that as Shi is the later filed application and prosecution has not yet begun. Therefore, Applicants respectfully request that the current obviousness-type double patenting rejection be withdrawn and presented in Shi, if deemed proper by the Examiner of that application.

In view of the foregoing, Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited. If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of the application, a telephone call to the undersigned is invited.

Respectfully submitted,

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